

REMARKS

Claims 1-21 and 23-87 are pending in the application. The Examiner has withdrawn the rejection of Claims 1-21 and 23-85 and 87 as set forth in the prior rejection. However, the Examiner makes a new ground of rejection under 35 U.S.C. §103(a) based upon Vatter, U.S. Patent No. 6,696,049.

Claims 1-21 and 23-87 remain rejected under 35 U.S.C. §103(a) as unpatentable over Vatter alone, or if necessary, in view of McDermott, U.S. Patent No. 6,248,336 and Shah, WO00/47168.

The Examiner states:

*The claims are drawn to a water and oil emulsion composition comprising at least one silicone resin film forming polymer, at least one silicone/acrylate copolymer, or a vinyl/silicone copolymer or mixtures thereof, at least one organic pigment wherein water is in an amount of 0.1-95% and oil is in an amount of 0.1-99% by weight.*

The Examiner then discusses Vatter:

*Vatter's patented composition used for skin care products (e.g. eye make-up products such as eye shadow) comprising at least one silicone resin film forming polymer and silicone-acrylate type copolymers such as SA70, see col. 12, lines 38-48. The colorants comprising inorganic or organic pigments are taught at col. 17, lines 10-45. Furthermore, US'049 (hereinafter) teaches ater (0-95%, see col., 10, lines 45-47) and oils (cols. 8, line 4-col. 10, lines 40). Viscosity agent, volatile solvent, non-volatile oil, a dry particulate matter, etc are taught by the cited reference throughout the patented disclosure.*

The Examiner concludes:

*As mentioned in the previous office action, the variations are considered to be minor and the modifications are routinely practiced (see Cosmetics Science and Technology: color in Cosmetic, Chapter 44 (1957) by Samuel Zuckerman, previously provided). Thus, it is the Examiner's position that one having ordinary skill in the art would readily recognize that how to modify the formulation utilizing the ingredients taught and suggested by Vatter's to make the final cosmetic composition to satisfy user's need with better appearance and quality when Vatter's reference is taken alone or if necessary taken in view of Shah and McDermott (their teachings are mentioned in*

*previous office action) because it is well within the skill of those having ordinary skill in the art to adjust and employ different ingredients to arrive at a desired quality.*

*Although all the elements are not specifically included in any examples, one of ordinary skill in the art would have been readily understand and modify with proper substitution as suggested by Vatter's teaching. Thus, all the critical elements which are well taught by the reference and thus, the claimed subject matter is obvious variation and not patentable distinct over the prior art of record.*

Applicants respectfully disagree. Vatter teaches cosmetic compositions containing a combination of emulsifying and non-emulsifying crosslinked silicone elastomers. The compositions may be anhydrous or water-containing and are for applying color to the face or skin. The focus of patentability for Vatter is the cosmetic composition containing the elastomer combination, a solvent, and optionally a skin conditioning agent. Beginning at Column 10, line 50, Vatter begins a list of so-called optional ingredients that spans many, many pages....shine control agents (from Col. 10, line 50 through Col. 12, line 24); film forming agents (from Col. 12, line 26 through Col. 13, line 5); skin conditioning agents (Col. 13, line 6 through Col. 17, line 10); colorant (Col 17, line 11 through Col. 18, line 35); dispersants, emulsifiers, UVA absorbers, physical sunscreens, and so on.

The silicone resin and silicone/acrylate copolymer of Applicants' claims are one of approximately hundreds of possible different film formers that Vatter teaches could be incorporated as optional additives into the cosmetic composition of his invention. The only way one skilled in the art could arrive at Applicants' claimed composition is by using Applicants' own specification as a road map, for there is certainly no suggestion that there would be any advantage to be derived from selecting those two film formers from Vatter's encyclopedic list.

It has been well established that it is insufficient that the prior art discloses the components of the claimed invention, either separately or in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by appellants. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985) (insufficient to select from the prior art the separate components of the inventor's combination, using the blueprint supplied by the inventor).

Here, there is no evidence or teaching within the four corners of Vatter that would direct one of ordinary skill to select a silicone resin and a silicone/acrylate copolymer from Vatter to arrive at Applicants' claimed composition.

As set forth in In re Kotzab, 217 F.3d 1365, 1369-70, 55 U.S.P.Q. 2d 1313, 1316 (Fed. Cir. 2000):

A critical step in analyzing the patentability of claims pursuant to section 103(a) is casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher. . .

Most if not all inventions arise from a combination of old elements. . . . Thus, every element of a claimed invention may often be found in the prior art. . . . However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. . . . Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. [citations omitted]

Nor do Shah or McDermott cure the deficiencies of Vatter. McDermott teaches mascara compositions in emulsion form. McDermott's compositions contain one or more film forming polymers in aqueous emulsion, lipophilic oil components including

PVP/hexadecane copolymer in an emulsion system. McDermott lists a wide variety of film forming polymers, none of which are even silicone, much less the silicone resin and silicone/acrylate copolymer of Applicants' claims. If McDermott doesn't even mention these materials it is hard to see how that reference could be considered to provide a suggestion sufficient to overcome the deficiencies of Vatter in failing to suggest the advantage of such a combination.

And Shah teaches long wearing compositions that contain, as the long wearing component, an acrylic or methacrylic derived component in combination with at least one water soluble organic pigment. Shah describes the types of acrylic or methacrylic based polymers as "homopolymers and copolymers of acrylic acid, methacrylic acid, and esters of acrylic or methacrylic acid and salts thereof". Shah does not teach that the polymer should contain silicone portions at all, much less be a silicone/acrylate copolymer. Shah also fails in providing the suggestion, also absent in McDermott and Vatter, to combine a silicone resin and a silicone/acrylate copolymer to arrive at Applicants' claimed cosmetic composition.

As stated in Echolochem, Inc. v. Southern California Edison, 227 F.3d 1361, 1375, 56 U.S.P.Q. 2d 1065, 1075-76 (Fed. Cir. 2000) "There still must be evidence that a skilled artisan, . . . with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed."

Here, there is no such evidence. Thus, this rejection reasonably appears to be based on the use of hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. Even with the use of hindsight, no reconstruction would be possible to arrive at the claimed compositions using the

references cited by the Examiner for none of the references cited other than Vatter teach silicone resins and silicone/acrylate or vinyl/silicone copolymers.

**Conclusion:**

The Examiner is respectfully requested to reconsider the patentability of all claims pending in the application. Vatter does not provide any suggestion to select, specifically a silicone resin and a silicone/acrylate or vinyl/silicone copolymer from the encyclopedic disclosure of the patent and combine them to form Applicants' claimed composition. Nothing in Shah or McDermott provides such a suggestion either, or otherwise cures Vatter's deficiency. It is Applicants' position that the only way one could arrive at the claimed composition is to use their own disclosure as a guide for picking and choosing the components necessary to arrive at the claimed composition.

The Examiner is respectfully requested to reconsider the rejection of the claims under 35 U.S.C. §103(a).

Respectfully Submitted,



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